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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,498	02/12/2004	Donald P. Ewing	1456-2U	5239
31292 7590 07/15/2008 CHRISTOPHER & WEISBERG, P.A. 200 EAST LAS OLAS BOULEVARD SUITE 2040 FORT LAUDERDALE, FL 33301				
EXAMINER CEGIELNIK, URSZULA M				
ART UNIT		PAPER NUMBER		
3711				
MAIL DATE		DELIVERY MODE		
07/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,498

Applicant(s)

EWING ET AL.

Examiner

Urszula M. Cegielnik

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1, 3, 4, 6, 8, 11, and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert (US Patent No. 6,961,622).

Gilbert discloses a flexible housing (col. 6, line 12) conformable to a portion of a body, said housing being formed by one or more layers of water resistant material (the layers are substantially water resistant being made of polyethylene (which is thermoplastic) foam and protecting circuitry to a degree); a control circuit connected directly to two or more electrodes wherein said control circuit and said electrodes are substantially contained within the housing (col. 5, lines 60-67 through col. 6, lines 1-4); and a layer of electrical insulation surrounding at least a portion of the control circuit; a body; and wherein said apparatus is attachable to said body with adhesive comprising one or more electrogel pads; voltage intensity control; a battery (46); hydrogel; display indicating status and intensity.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent No. 6,961,622) in view of Silverstone (US Patent No. 6,351,674).

Gilbert discloses the claimed invention except for an adjustable voltage intensity ranging from 90 to 180 volts.

Silverstone teaches an electrical stimulation device with voltages in the range between 90 and 180 volts (col. 3, lines 19-20).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the abovementioned claimed features as taught by Silverstone, since Silverstone states at col. 3, lines 19-20, that such voltages are known of typical stimulators.

Claims 5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent No. 6,961,622) in view of Reiss (US Patent No. 5,549,656).

Gilbert discloses the claimed invention except for the body receiving approximately 15 to 19.5 volts when the apparatus is attached on the body and low intensity is activated.

Reiss teaches the body receiving 0 to 60 volts (a range in which the claimed values fall within) when the apparatus is attached on the body and the claimed intensity is activated (col. 3, lines 26-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the abovementioned claimed feature as taught by Reiss, since such a modification would provide the desired intensity of voltage to be administered.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent No. 6,961,622).

Gilbert discloses the claimed invention except for the polymeric material of the housing being polyvinyl chloride.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the housing made of polyvinyl chloride, since the examiner takes Official Notice of the equivalence of polyvinyl chloride and polyethylene for their use in the foam art and the selection of any of these shown equivalents to provide a foam housing would be within the level of ordinary skill in the art.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent No. 6,961,622) in view of Beggs (US Patent No. 6,917,293).

Gilbert discloses the claimed invention including the apparatus powered by a battery.

Gilbert does not explicitly mention the battery being a 3-volt lithium battery.

Beggs teaches an apparatus powered by a 3-volt lithium battery (col. 14, line 26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the abovementioned claimed feature as taught by

Beggs, since such a medication would provide a power source that is both portable and compact.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent No. 6,961,622) in view of Liss et al. (US Patent No. 5,851,223).

Gilbert discloses the claimed invention except for the apparatus outputting a square waveform at a constant current.

Liss et al. teach an apparatus outputting a square waveform at a constant current (see Figure 1C, for example).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the abovementioned claimed feature as taught by Liss et al., since such a modification would permit the timing of the control circuitry.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable Gilbert (US Patent No. 6,961,622) in view of Thomas (US Patent No. 5,107,835),

Gilbert discloses the claimed invention except the apparatus using a frequency of approximately 0.1 to 4000 Hertz.

Thomas teaches an apparatus using a frequency of approximately 0.1 to 4000 Hertz (col. 2, lines 19-25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the abovementioned claimed feature as taught by Thomas, since Thomas states at col. 2, lines 19-20 that such a modification would decrease inflammation in an afflicted region in a patient.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent No. 6,961,622) in view of DiLorenzo (US Patent Application Publication No. 2003/0018367).

Gilbert discloses the claimed invention except for the apparatus having a pulse width of approximately 45 milliseconds and a range from .01 microsecond to 50 milliseconds.

DiLorenzo teaches an apparatus having a pulse width in the range of 1 microsecond and 1000 milliseconds (paragraph 0100, lines 8-10).

With regards to providing a pulse width from the range of .01 microsecond, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a pulse width from the range of .01 microsecond, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 333.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent No. 6,961,622) in view of Zilber (US Patent No. 3,822,708),

Gilbert discloses the claimed invention except for the apparatus outputting approximately thirty pulses over a four second duration.

Zilber teaches an apparatus outputting 5 to 200 pulses per second (col. 4, line 9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the abovementioned claimed feature as taught by Zilber, since such a modification would permit a certain value of current to be passed.

With regards to providing the time period being four seconds, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a time period being four seconds, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 333.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 571-272-4420. The examiner can normally be reached on Monday through Friday, from 5:45AM-2:15PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Umc
/Gene Kim/
Supervisory Patent Examiner, Art Unit 3711